

**REMARKS**

***Summary of the Amendment***

Upon entry of the above amendment, the amended specification will have been replaced by a Substitute Specification as required by the Examiner. Additionally, claims 29-70 will have been canceled and claims 71-97 will have been added. Accordingly, claims 71-97 will be pending. Moreover, claim 71 is in independent form.

***Summary of the Official Action***

In the Office action, the Examiner failed to acknowledge foreign priority and failed to indicate whether all, some, or none of the certified priority documents have been received. The Examiner also failed to indicate whether the drawings filed on August 22, 2001 are acceptable to the Examiner. Additionally, claims 30-43, 46, 47, 49-52 and 55 were withdrawn from examination by the Examiner due to a species election, which was made final. Next, the Examiner required submission of a substitute specification and rejected "All claims" on the basis of obviousness-type double patenting over US 6,299,646. The Examiner also rejected claims 44 and 45 as indefinite. Claims 29, 44, 45, 48, 53, 54, 56, 57, 58, 62-65, 67 and 70 were rejected over the art of record. Finally, claims 59-61, 66, 68 and 69 were indicated to contain allowable subject matter subject to being presented in independent form. By the present amendment and remarks, Applicant submits that the rejections have been

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overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

***Request for Acknowledgment of foreign priority***

The Examiner failed to Acknowledge Applicant's claim of foreign priority and failed to indicate whether all, some, or none of the certified priority documents have been received.

Applicant respectfully requests that the Examiner indicate that all of the certified priority documents have been received in the parent application.

***Request for Acceptance of drawings***

The Examiner failed to indicate whether the drawings filed on August 22, 2001 were acceptable.

Applicant respectfully requests that the Examiner indicate that the drawings filed August 22, 2001 are acceptable.

***Requirement of Substitute Specification***

The Examiner indicated that a Substitute Specification was required. Accordingly, Applicant is concurrently filing herewith a Substitute Specification which includes all the changes made by the previously entered Preliminary Amendments (the claims are not

attached to the Substitute Specification). Moreover, all the paragraphs of the Substitute Specification have been numbered. Pursuant to 37 C.F.R. section 1.125(b), Applicant submits that no new matter has been added in the Substitute Specification.

***Restriction Requirement***

Claims 30-43, 46, 47, 49-52 and 55 were withdrawn by the Examiner as directed to non-elected species. The Examiner also indicated that there was no allowable generic or linking claim. Moreover, the Examiner has made the restriction final.

Applicant notes that claims 29 and 58, while not indicated to be allowable, are nevertheless generic. Moreover, in view of the fact that claims 29-70 have been canceled in favor of new claims 71-97, and because all of the claims depend from claim 71, Applicant requests that the Examiner examine at least generic claim 71 and the dependent claims deemed to read on the elected species. Further, Applicant expects that any non-elected claims (to the extent that the new dependent claims are determined to be drawn to a non-elected species) will be rejoined if claim 71 is found to be allowable.

***Acknowledgment of Allowable Subject Matter***

Applicant acknowledges and appreciates the Examiner's indication that claims 59-61, 66, 68 and 69 contain allowable subject matter and would be allowable if written in independent form. However, in view of the fact that claims 29-70 have been canceled in

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favor of claims 71-97, Applicant is not presenting these claims in independent form at this time because it is believed that the new claims contain allowable subject matter.

***Rejection under 35 U.S.C. § 112, second paragraph, is moot***

Claims 44 and 45 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

By this amendment, Applicant has canceled these claims in favor of new claims which even more clearly recite the features of the invention. Thus, it is believed that each issue indicated by the Examiner has been addressed. Accordingly, the rejection has been rendered moot and the Examiner is requested to withdraw the indefiniteness rejection.

***Traversal of Rejections Under 35 U.S.C. § 102***

***Over Gerard***

Applicant traverses the rejection of claims 29, 44, 45, 48, 53, 54, 56 and 57 under 35 U.S.C. § 102(b) as being anticipated by French Patent No. 2 707 871 to GERARD et al.

The Examiner asserted that this document discloses all the features recited in these claims including the guide mechanism 30 and 31. Applicant respectfully traverses this rejection.

Applicant submits that GERARD fails to disclose the invention as defined by at least

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new independent claim 71. Notwithstanding the Office Action assertions as to what GERARD discloses, Applicant submits that GERARD fails to disclose, inter alia, that the said guide means (22, 22', 22'', 26, 29, 5, 6, 5', 9, 50, 51, 52, 13, 15, 18; 34, 34', 34'', 35, 37, 7, 8, 10, 12, 53, 54, 55, 10', 17) is positioned a certain distance away from the center of rotation (C, C') and is positioned *in the anterior part of the metal base (2) and oriented in a substantially medio-lateral direction*, as recited in independent claim 71.

It is apparent from Figs. 1-3 of GERARD that this document relates to a prosthesis in which the guide mechanism, i.e., parts 30 and 32, is arranged in the posterior part of the prosthesis. On the other hand, Applicant's invention provides for guide means, e.g., parts (22, 22', 22'', 26, 29, 5, 6, 5', 9, 50, 51, 52, 13, 15, 18; 34, 34', 34'', 35, 37, 7, 8, 10, 12, 53, 54, 55, 10', 17) which are arranged *in the anterior part of the metal base (2) and oriented in a substantially medio-lateral direction*.

Thus, Applicant submits that claims 71-97 are not disclosed by any proper reading of GERARD.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102(b) to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because GERARD fails to disclose at least the above mentioned features as recited in independent claim 71, Applicant submits that GERARD does not disclose all the claimed

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features recited in at least independent claim 71.

Furthermore, Applicant submits that dependent claims 72-97 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of GERARD discloses or suggests, in combination each of the features recited in new dependent claims 72-97.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b).

Over Pappas

Applicant traverses the rejection of claims 29, 44, 45, 48, 53, 54, 56, 57, 58, 62-65, 67 and 70 under 35 U.S.C. § 102(e) as being anticipated by US patent 5,683,468 to PAPPAS.

The Examiner asserted that this document, in particular Fig. 7, discloses all the features recited in these claims including the guide mechanism 432 and 437. Applicant respectfully traverses this rejection.

Applicant submits that PAPPAS fails to disclose the invention as defined by at least independent claim 71. Notwithstanding the Office Action assertions as to what PAPPAS discloses, Applicant submits that PAPPAS fails to disclose, inter alia, that the said guide means (22, 22', 22'', 26, 29, 5, 6, 5', 9, 50, 51, 52, 13, 15, 18; 34, 34', 34'', 35, 37, 7, 8, 10,

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12, 53, 54, 55, 10', 17) is positioned a certain distance away from the center of rotation (C, C') and is positioned *in the anterior part of the metal base (2) and oriented in a substantially medio-lateral direction*, as recited in independent claim 71.

It is apparent from Fig. 7 of PAPPAS that this document relates to a prosthesis in which the guide mechanism, i.e., parts 436 and 420, is arranged in the center part of the prosthesis. On the other hand, Applicant's invention as recited in claim 71 provides for a guide means, e.g., (22, 22', 22'', 26, 29, 5, 6, 5', 9, 50, 51, 52, 13, 15, 18; 34, 34', 34'', 35, 37, 7, 8, 10, 12, 53, 54, 55, 10', 17) that is positioned a certain distance away from the center of rotation (C, C') and that is positioned *in the anterior part of the metal base (2) and oriented in a substantially medio-lateral direction*.

Thus, Applicant submits that claims 71-97 are not disclosed by any proper reading of PAPPAS.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102(e) to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because PAPPAS fails to disclose at least the above mentioned features as recited in independent claim 71, Applicant submits that PAPPAS does not disclose all the claimed features recited in at least independent claim 71.

Furthermore, Applicant submits that dependent claims 72-97 are allowable at least for

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the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of PAPPAS discloses or suggests, in combination each of the features recited in new dependent claims 72-97.

Applicant requests that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102(e).

### ***Obviousness-type Double Patenting***

Claims 29-70 were rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting over all of the claims of US Patent No. 6,299,646.

While Applicant disagrees that the Examiner has set forth a proper prima facie basis for this rejection, Applicant is, in an effort to advance prosecution, attaching hereto a Terminal Disclaimer to obviate this rejection.

### **CONCLUSION**

Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 112 and 102 and respectfully requests the Examiner to indicate allowance of each and every pending claim of the present application.

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In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of claims 71-97. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Commissioner is hereby authorized to charge any fees necessary for consideration of this amendment to deposit account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,  
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